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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,780	04/12/2001	Domingo Figueras Payas	2136/0J098	9468

7590 07/28/2004

DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER

CULLER, JILL E

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/835,780	Applicant(s) FIGUERAS PAYAS, DOMINGO	
	Examiner Jill E. Culler	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/23/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040401</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Brief filed on May 6, 2004, PROSECUTION IS HEREBY

REOPENED. A new rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 452,933 to Feister in view of EPO 0895183 and U.S. Patent No. 3,593,987 to Garber.

Feister shows a printing and binding machine for the preparation of books which includes unrolling a sheet of paper and cutting it prior to printing, see lines 22-24, then printing on one side of the sheet and then the other, see lines 24-26, then folding the sheets about an axis of symmetry, see lines 33-34, and trimming the sheets, 34-35, to finish the text.

Feister does not teach an electronic printing machine having a memory for the content of the texts of the various pages and electronically controllable means for determining the surface area occupied by the text and the parameters defining the text, or printing the text symmetrically, varying the extent of the body of text for each page in accordance with the dimensions provided. Feister also does not discuss cutting the sheets at the outer edges or joining and binding the sets of sheets. Feister does not discuss that the adjustment of the parameters determining the texts and the arrangement on the sheet is effected by externally operated electronic controls of the printer without stopping the continuous process of manufacture. Feister also does not teach that each sheet is printed in an off-center manner to produce a lateral edge strip which is parallel with one of the edges.

EPO 0895183 teaches an electronic printing machine, having a memory for the content of the texts of the various pages and electronically controllable means for determining the surface area occupied by the text and the parameters defining the text, and teaches that the text is printed symmetrically, varying the extent of the body of text for each page in accordance with the dimensions provided, and that the adjustment of the parameters determining the texts and the arrangement on the sheet is effected by

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externally operated controls of the printer without stopping the continuous process of manufacture and that each sheet is printed in an off-center manner to produce a lateral edge strip which is parallel with one of the edges.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the printing machine of Feister with the electronic controls of EPO 0895183 in order to have better control over the printing process and the distribution of the text on the sheets.

Garber teaches a printing process in which the sheets are folded to form signatures, see column 3, lines 70-72, then a plurality of these signatures are bound together and trimmed. See column 4, lines 33-35.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the printing machine of Feister to fold before binding since Garber teaches that this is an advantageous method of creating a book.

With respect to claim 2, any sheet may be considered to be standard size for a particular printing apparatus or process.

With respect to claim 4, the claimed product results from the process as already discussed.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feister in view of EPO 0895183 and Garber as applied to claims 1-5 above, and further in view of U.S. Patent No. 5,291,227 to Suzuki.

Feister, EPO 0895183 and Garber teach all that is claimed, as in the above rejection of claims 1-5 except that the sheet is arranged with its edge displaced with respect to a reference edge of a base carrying the sheet, printing being effected in accordance with coordinate axes of the base, to produce a lateral edge for gripping.

Suzuki teaches a process of printing in which the sheet is arranged with its edge displaced with respect to a reference edge of a base carrying the sheet, printing being effected in accordance with coordinate axes of the base, to produce a lateral edge for gripping. See column 5, lines 64-68 and Figure 3.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the printing process of Feister to have the sheet displacement step of Suzuki in order to provide consistent margins at the sheet edges.

Allowable Subject Matter

5. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or render obvious a process for manufacturing sets of printed pages for the preparation of books as claimed, particularly including the step wherein a lateral edge strip is produced by a displacement of a base carrying the sheet along one or the other of coordinate axes of a magnitude equal to that of the desired edge strip.

Response to Arguments

6. Applicant's arguments filed 7/23/03 and 5/06/04 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the rejection of claims 1-5, applicant appears to be arguing that a center of symmetry results in text printed in separate bodies of text which are symmetrical in all directions, however this is not supported by the claims. Although it is agreed that Feister does not explicitly teach printing text with respect to a center of symmetry, a center of symmetry would inherently exist at some point along the axis of symmetry in Feister. Therefore, the recitation of printing text symmetrically with respect to a center of symmetry is not sufficient to patentably distinguish the claimed invention over the prior art.

Conclusion

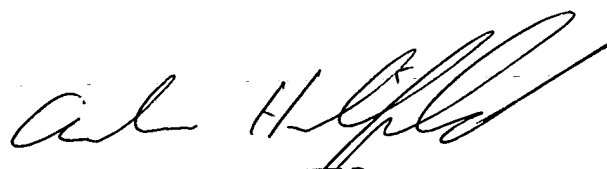
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 4,737,645 to Lahr, U.S. Patent No. 4,930,912 to Speicher, and U.S. Patent No. 5,461,977 to Germann each teach a printing process having obvious similarities to the claimed subject matter.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (571) 272-2159. The examiner can normally be reached on M-Th 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jec



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